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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,421	04/19/2006	Tetsuya Hayashi	043888-0447	9484
53080 7590 04/16/2009 MCDERMOTT WILL & EMERY LLP 600 13TH STREET, NW WASHINGTON, DC 20005-3096				
EXAMINER				
RADEMAKER, CLAIRE L				
ART UNIT		PAPER NUMBER		
1795				
MAIL DATE		DELIVERY MODE		
04/16/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/576,421

Applicant(s)

HAYASHI ET AL.

Examiner

CLAIRE L. RADEMAKER

Art Unit

1795

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Alexa D. Neckel/
Supervisory Patent Examiner, Art Unit 1795

Continuation of 11, does NOT place the application in condition for allowance because: the Applicant's arguments were not persuasive.

On page 3 of the Applicant's Response, Applicants argue that "since the porous film is formed of filler and binder, these cannot be arranged such as in Mizutani, because it would not be possible to roll up the porous film and electrode combination of the present disclosure around a jig such as in Mizutani, without causing cracks in the film, because the winding around the jig is much tighter than the winding core" (Applicant's Response, page 3).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The Applicants argument against the combination of Mizutani (US 2003/0180605) and Reichert et al. (US 6,214,623) to reject the concept of rolling a porous film and electrode combination around a jig (Applicant's Response, page 3) is not persuasive because the Examiner uses the combination of Mizutani, Reichert et al., and Takayama (JP 09-035738) to reject the concept of rolling a porous film and electrode combination around a winding core. Therefore, the Applicant is attacking the Mizutani and Reichert et al. references individually where the rejection is based on combinations of references Mizutani, Reichert et al., and Takayama.

On pages 3-4 of the Applicant's Response, Applicants argue that "in Mizutani, the electrodes must be rolled up in one sheet of separator. Thus, the one sheet is required to have a projected area larger than the total of the projected area of the positive and negative electrodes... [while] in the present disclosure... the projected area of the porous film is equal to or less than the total of the projected area of the positive and negative electrodes" (Applicant's Response, page 4).

The Examiner respectfully disagrees with the Applicants argument that "in Mizutani, the electrodes must be rolled up in one sheet of separator. Thus, the one sheet is required to have a projected area larger than the total of the projected area of the positive and negative electrodes... [while] in the present disclosure... the projected area of the porous film is equal to or less than the total of the projected area of the positive and negative electrodes" (Applicant's Response, page 4) because 1) if the projected area of the separator / porous film of the instant invention was less than the total of the projected area of the positive and negative electrodes, then the battery could short circuit because there could be nothing to keep the positive and negative electrodes from touching, and 2) the instant claims of the invention do not require the projected area of the porous film be equal to the total of the projected area of the positive and negative electrodes.

On page 4 of the Applicant's Response, Applicants argue that "one skilled in the art would interpret this passage [of Reichert which discusses the porous film layer can be sprayed directly onto either or both anode or cathode] as meaning that a porous film is sprayed on either the positive or the negative electrode, or alternatively, on both... Reichert does not teach or suggest providing the positive and negative electrodes on both faces of the porous film, or any specific method for providing the positive and negative electrodes on both faces of the porous film" (Applicant's Response, page 4).

In response to the Applicants argument that "one skilled in the art would interpret this passage [of Reichert which discusses the porous film layer can be sprayed directly onto either or both anode or cathode] as meaning that a porous film is sprayed on either the positive or the negative electrode, or alternatively, on both... Reichert does not teach or suggest providing the positive and negative electrodes on both faces of the porous film, or any specific method for providing the positive and negative electrodes on both faces of the porous film" (Applicant's Response, page 4), the Examiner maintains that one of ordinary skill in the art would understand that the passage of Reichert which clearly states that the porous film layer can be sprayed "directly onto either of both anode or cathode" (col. 5, lines 32-39) supports the concept of the positive and negative electrodes being disposed on both faces of one porous film.

On pages 4-5 of the Applicant's Response, Applicants argue that "regardless of how Mizutani eliminates non-contributing components, the addition of a winding core would still not fulfill Mizutani's stated goal of eliminating a component that does not contribute to power generation" (Applicant's Response, page 5).

In response to the Applicant's argument that "regardless of how Mizutani eliminates non-contributing components, the addition of a winding core would still not fulfill Mizutani's stated goal of eliminating a component that does not contribute to power generation" (Applicant's Response, page 5), the Examiner maintains that Mizutani clearly states that the component which is being eliminated in order to improve energy density is the active material layer on the outermost periphery of the wound electrode because it has substantially no contribution to the electromotive as a battery (Mizutani, paragraphs [0015], [0056], & [080]).

On pages 5 of the Applicant's Response, Applicants argue that "Mizutani does not require a winding core of any kind. Thus, regardless of how the winding core is shaped, or where it is located, Mizutani still does not disclose a winding core" (Applicant's Response, page 5).

In response to the Applicant's argument that "Mizutani does not require a winding core of any kind. Thus, regardless of how the winding core is shaped, or where it is located, Mizutani still does not disclose a winding core" (Applicant's Response, page 5), the Examiner notes that Takayama is used to teach that it is advantageous to use a winding core with a recess instead of a removable jig such as that used in Mizutani.